

Amendment after Final
Ser. No.: 10/075,580
Richard C. Everett

REMARKS

The Office Action mailed 05/21/2003 was marked "FINAL". As part of a Request for Continued Examination Transmittal applicant submits this Amendment in response to the Office Action. In the Office Action the Examiner has rejected claims 1-14 under 35 U.S.C.112, second paragraph, as being indefinite and rejected claims 1-20 under 35 U.S.C.103(a) as being unpatentable over Penney (US 471,891) in view of Everett (US 5,896,955).

Rejection under 35 U.S.C.112, second paragraph

The Examiner has rejected claims 1-14 as being indefinite in that "brake shoe means" in claims 1 and 8 lacks antecedent basis, claims 2-7 and 9-14 being indefinite due to dependency on claims 1 and 8, respectively. This informality has been corrected in that "means" has been struck from claims 1 and 8.

Rejection under 35 U.S.C 103(a)

In rejecting claims 1-20 the Examiner refers to previous discussions of Penny and Everett in paper number 2 mailed 11-2-2002. He further alleges that Penny shows a brake assembly of the type claimed having plural pads B slidably fit onto shoe body A, the claimed invention differing only in the intended use, and in using pads having varying braking characteristics as disclosed in Everett. In making the rejection the Examiner is essentially alleging that the differences between applicant's claimed bicycle brake assembly and the wagon brake of Penny, modified with pads of different braking characteristics, would have been obvious to one having ordinary skill in the art at the time applicant's invention was made. Such rejection is respectfully traversed for the following reasons.

- (1) As to any rejection under 35 U.S.C. 103(a), the mere fact that the prior art may be modified in a manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification In re Gordon, 723 F.2d at 902, 221 USPQ at 1127.

Penny discloses a metal brake shoe body having brake blocks of wood or other suitable materials (metal, rawhide) mounted to the outer rim, or face, of a wagon wheel for rolling frictional application to the surface of the road. The blocks slide into a groove and are locked into the support via a pin. However, there is no suggestion in Penny that the teachings of Everett could be combined to result in a workable device, much less applicant's claimed invention. For instance, there is no teaching or suggestion in Penny of the desirability of applying the brake shoe to the side of the wagon wheel. Further, there is no teaching or suggestion in Penny that the brake blocks could be of selected different braking material and somehow arranged in the brake shoe body against the side of the wheel to provide different frictional characteristics by the wagon wheel to the ground. Additionally, there is no teaching or suggestion in Penny of multiple composition brake blocks either molded unitarily or formed as snap inserts in the blocks. It is thus clear that the sole disclosure and teachings of Penny is simply to slidably replace ground contact brake blocks of then conventional materials when they become worn.

Everett discloses a bicycle brake shoe having multiple composition brake pads for providing different braking characteristics to the brake shoe for application to the sides of the bicycle tire. The different pads are either molded unitarily with the main body portion or formed as snap inserts in the main body portion. There is no teaching or suggestion in Everett of modification to conform to the curvature of the wheel rim, to be applied to the face of the bicycle tire for rolling contact with the ground, or for the pads to be slidably inserted individually and consequentially into a holder.

Thus, there is no teaching or suggestion in either reference suggesting the desirability of the modification suggested by the Examiner.

(2) References may be combined to anticipate a claim, but their teachings must be capable of suggesting to one skilled in the art, without exercising inventive faculties, their combination in a manner disclosed in the claimed structure. The claim will be allowed where one skilled in the art, with the prior art before him, but in the absence of applicant's disclosure, would be incapable of constructing the claimed structure without displaying creative genius (Ex parte Warhol, 94 USPQ 193, In re Irmscher, 120 USPQ 196).

As discussed in (1) above, even if the teaching of Penny and Everett were combined as suggested by the Examiner, there would not result in a workable device, much less applicant's claimed invention. Thus, in view of the above, it is submitted that the Examiner has made a "hind-sight" rejection. That is, in the absence of applicant's disclosure, one skilled in the art, with the prior art before him, would not be capable of constructing applicant's claimed structure without exercising inventive faculties.

(3) To allege that applicant's invention (filed in 2002) is obvious from Penny (issued in 1892) in view of Everett (filed in 1997) is to ignore that over four years elapsed from Everett disclosing different brake pads in the same holder providing different braking characteristics until applicant's present invention. The bicycle brake business is very competitive with obvious improvements and modifications occurring within months or a year at most, certainly not over four years later. During this interim many competitive products attempting to employ the invention of Everett without infringement have come to market, yet applicant's present invention was not brought to market. Thus, there has been a relative long existing unfilled need for applicant's invention. It is submitted that this long existing unfilled need serves to negate the Examiner's rejection for obviousness.

Applicant's independent claims 1, 8 and 15, from which the remainder of the rejected claims depend, either directly or indirectly, recites structure neither taught or suggested in Penny, Everett, or the combination thereof. For example, as variously claimed by applicant in the aforesaid independent claims, the references do not teach or suggest at least the following:

"said brake pads sequentially and slidably positioned within said brake shoe in abutting relationship with each formed of a different braking compound for imparting a variety of desired braking characteristics to said brake pad assembly";

"individually molded brake pads in abutting sequential arrangement configured for slideable replacement and interchangeability";

a brake shoe that "has longitudinal curvature substantially in conformance with the radius of the bicycle wheel rim";

"said brake shoe includes inwardly projecting shoulders configured for coacting with said brake pad indentations whereby said brake pads are slidably received along said shoulders in said brake shoe.

In view of the above, it is submitted that the Examiners burden has not been met under 35 U.S.C. 103(a) in that the limitations contained in applicant's amended claims are neither taught nor suggested in the art of record. It is thus respectfully requested that the Examiner's rejections be reconsidered and the claims in the case, that is amended independent claims 1, 8 and 15, and claims 2-7, 9, 10, 12-14 and 16-20 variously dependent therefrom, be allowed and the case passed to issue. If a telephone call will help in expediting this case, please call the undersigned attorney for applicant as indicated below.

Respectively submitted,



Edward E. Roberts 08/20/03

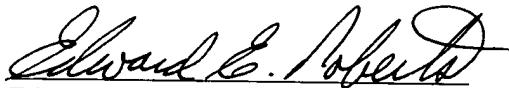
Edward E. Roberts
Attorney for Applicant
(949) 365-5717

Date

P.O. Box 3206
Dana Point, CA 92629

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service, postage prepaid, in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on 20 August 2003.



Edward E. Roberts

Edward E. Roberts
Reg. No. 26,024